

REMARKS

By this Amendment, Applicants amend claims 1, 4-6, 11, 12, and 16-18. Claims 1-12 and 14-21 are pending.

In the Office Action,¹ the Examiner alleged that the Information Disclosure Statement filed on March 7, 2005 is non-compliant; rejected claims 1-12 and 14-21 under 35 U.S.C. § 112, second paragraph, as being indefinite; rejected claims 1-10, 12, and 14-21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claims 1-3, 5-9, 11, 12, 14, 15, and 17-21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,594,683 to Furlani et al. ("*Furlani*"); rejected claims 4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Furlani* in view of U.S. Patent No. 5,566,319 to Lenz ("*Lenz*"); and rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Furlani* in view of Applicants' admitted prior art ("*AAPA*").

I. Information Disclosure Statement

The Examiner did not consider Stefani, H., "Datenarchivierung mit SAP" ("*Stefani*") submitted with the Information Disclosure Statement ("IDS") filed on March 7, 2005. The Examiner alleges that the IDS "fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the cited Non Patent Literature document 'Datenarchivierung mit SAP' is not in the English language." Office Action at 2. Furthermore, the Examiner requests an English translation of *Stefani*. *Id.*

¹ The Office Action contains a number of statements reflecting characterizations of the related art, case law, and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

However, *Stefani* was cited in an International Search Report (“ISR”) for a counterpart international application. Furthermore, M.P.E.P. states:

Where the information listed is not in the English language, but was cited in a search report . . . by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report . . . which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an ‘X’, ‘Y’, or ‘A’ indication on a search report.

M.P.E.P. § 609.04(a)(III), 8th Ed., Rev. 6 (Sept. 2007). The ISR citing *Stefani* is in the English language and includes specific portions of *Stefani*, a list of claims to which *Stefani* applies, and an “X” indication. The ISR was submitted with the IDS in lieu of a concise explanation of relevance. Accordingly, the IDS is compliant and the Examiner should have considered *Stefani*.

Nevertheless, to advance prosecution, Applicants have obtained and submit herewith an English-language translation² of the cited pages of *Stefani*. Therefore, Applicants respectfully request that the Examiner consider *Stefani* and appropriate initial the SB/08 form attached for the Examiner’s convenience.

II. Rejection of Claims 1-12 and 14-21 Under 35 U.S.C. § 112, Second Paragraph

Regarding the rejection of claims 1-12 and 14-21 under 35 U.S.C. § 112, second paragraph, as being indefinite, the Examiner states “claims 1, 11 and 12 . . . recite the limitation ‘the lock object[,]’ . . . [h]owever, it is unclear as to which of the first or second

² The submitted translation is a translation of the second edition, copyrighted 2007.

lock object this limitation references.” Office Action at 3. Although Applicants respectfully traverse the rejection, to advance prosecution, Applicants amend independent claims 1, 11, and 12 to address the Examiner’s concerns. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-12 and 14-21 under 35 U.S.C. § 112, second paragraph.

III. Rejection of Claims 1-10, 12, and 14-21 Under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 1-10, 12, and 14-21 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Regarding independent claim 1, the Examiner alleges that “data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory.” Office Action at 3. Although the Examiner’s allegation is incorrect, to advance prosecution, Applicants amend claim 1 to recite “[a] data structure tangibly embodied in a computer-readable storage medium.”

Regarding independent claim 12, the Examiner alleges that “claim [12] is not statutory because the claim does not require the instructions to be stored within the computer readable medium or executed therein.” Office Action at 4. Although the Examiner’s allegation is incorrect, to advance prosecution, Applicants amend claim 12 to recite “[a] computer readable medium storing executable instructions which, when executed, create a data structure,” as suggested by the Examiner.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-10, 12, and 14-21 under 35 U.S.C. § 101.

IV. Rejection of Claims 1-3, 5-9, 11, 12, 14, 15, and 17-21 Under 35 U.S.C. § 102(e)

Applicants respectfully traverse the rejection of claims 1-3, 5-9, 11, 12, 14, 15, and 17-21 under 35 U.S.C. § 102(e) as being anticipated by *Furlani*. In order to properly establish that *Furlani* anticipates Applicants' claims under 35 U.S.C. § 102, each and every element of each of the claims must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant submits that *Furlani* does not teach each and every element of Applicants' claims.

Independent claim 1 recites a data structure comprising, among other things, "a first lock object, in which the ID is stored if the data object is being accessed, and in which a link to a second storage location storing a copy of the data object is assigned to the ID."

The Examiner alleges that group lock object 303 of *Furlani* corresponds to the claimed "first lock object" and that LockObject ID 325 of *Furlani* corresponds to the claimed "ID." Office Action at 5. The Examiner's allegations are incorrect.

Claim 1 recites that "the ID is stored [in the first lock object] if the data object is being accessed." (Emphasis added.) However, in *Furlani*, group lock object 303 always stores LockObject ID 325 regardless of whether "the data object is being accessed." See *Furlani*, Fig. 3. *Furlani* fails to disclose any situation in which group lock object 303 does not store LockObject ID 325. The only variation mentioned in

Furlani is that "[group lock identification] field [(LockObject ID)] 325 . . . contains a monotonically increasing identification value." *Furlani*, col. 8, lines 47-48. Therefore, although LockObject ID 325 may contain varying values, LockObject ID 325 is always stored in group lock object 303. Accordingly, *Furlani* fails to teach or suggest "a first lock object, in which the ID is stored if the data object is being accessed," as recited in claim 1 (emphasis added).

Furthermore, claim 1 recites that "a data object . . . [is] stored in a first storage location" and further recites "a second storage location storing a copy of the data object." (Emphasis added.) *Furlani* fails to teach or suggest any "second storage location storing a copy of the data object [stored in a first storage location]," as recited in claim 1. Even if Number References 323, reference lock pointer 327, or Bag of References 328 could be considered a link, none of these is "a link to a second storage location storing a copy of the data object [stored in a first storage location]," as recited in claim 1. Accordingly, *Furlani* fails to teach or suggest "a first lock object, . . . in which a link to a second storage location storing a copy of the data object is assigned to the ID," as recited in claim 1.

In addition, *Furlani* fails to teach or suggest other elements of claim 1. For example, claim 1 recites "a second lock object, in which the ID is stored."

The Examiner alleges that reference lock object 301 of *Furlani* corresponds to the claimed "second lock object" and that MaxLockObject ID 313 of *Furlani* corresponds to the claimed "ID." The Examiner's allegation is incorrect.

Claim 1 recites “a first lock object, in which the ID is stored” and “a second lock object, in which the [same] ID is stored.” However, in *Furlani*, group lock object 303 stores LockObject ID 325 whereas reference lock object 301 stores a different ID, namely, MaxLockObject ID 313. *Furlani* fails to disclose any lock object storing an ID that is the same ID stored in another lock object. Accordingly, *Furlani* fails to teach or suggest “a second lock object, in which the ID is stored,” as recited in claim 1.

For at least the foregoing reasons, *Furlani* fails to teach or suggest each and every element of claim 1. *Furlani* thus fails to anticipate claim 1. Furthermore, independent claims 11 and 12, although different in scope from claim 1, are allowable for at least reasons similar to those given for claim 1. In addition, dependent claims 2, 3, 5-9, 14, 15, and 17-21 are allowable at least due to their dependence from allowable base claims 1, 11, and 12. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-3, 5-9, 11, 12, 14, 15, and 17-21 under 35 U.S.C. § 102(e).

V. Rejection of Claims 4 and 16 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 4 and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Furlani* in view of *Lenz*. A *prima facie* case of obviousness has not been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” M.P.E.P. § 2142(III). “[T]he framework for objective analysis for determining obviousness under

35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966). . . . The factual inquiries . . . are as follows:

(A) [Determining the scope and content of the prior art;]

(B) Ascertaining the differences between the claimed invention and the prior art;

and

(C) Resolving the level of ordinary skill in the pertinent art."

M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

As discussed above, *Furlani* fails to teach or suggest "a first lock object, in which the ID is stored if the data object is being accessed, and in which a link to a second storage location storing a copy of the data object is assigned to the ID" and "a second lock object, in which the ID is stored," as recited in claims 1, 11, and 12, and required by dependent claims 4 and 16. *Lenz* fails to cure the deficiencies of *Furlani*. That is, *Lenz* also fails to teach or suggest "a first lock object, in which the ID is stored if the data object is being accessed, and in which a link to a second storage location storing a copy of the data object is assigned to the ID" and "a second lock object, in which the ID is stored," as required by dependent claims 4 and 16.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claims 4 and 16 have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claims 4 and 16 obvious to one

of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect to claims 4 and 16. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 4 and 16 under 35 U.S.C. § 103(a).

VI. Rejection of Claim 10 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Furlani* in view of *AAPA*. A *prima facie* case of obviousness has not been established.

As discussed above, *Furlani* fails to teach or suggest “a first lock object, in which the ID is stored if the data object is being accessed, and in which a link to a second storage location storing a copy of the data object is assigned to the ID” and “a second lock object, in which the ID is stored,” as recited in claim 1, and required by dependent claim 10. *AAPA* fails to cure the deficiencies of *Furlani*. That is, *AAPA* also fails to teach or suggest “a first lock object, in which the ID is stored if the data object is being accessed, and in which a link to a second storage location storing a copy of the data object is assigned to the ID” and “a second lock object, in which the ID is stored,” as required by dependent claim 10.

For at least the foregoing reasons, the scope and content of the prior art have not been properly determined, and the differences between the prior art and claim 10 have not been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered claim 10 obvious to one of ordinary skill in the art. Therefore, a *prima facie* case of obviousness has not been established with respect

to claim 10. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 10 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: August 21, 2008

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Attachments: Translation of "Datenarchivierung mit SAP" and a clean copy of the SB/08 form submitted with the IDS filed on March 7, 2005.